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JJGJr: 06-03

Paper No: 9

JDS UNIPHASE CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
3000 MERIVALE ROAD
OTTAWA ON
K2G 6N7
CANADA

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JUN 27 2003

OFFICE OF PETITIONS

In re Application of:

Delisle, et al.

Filed: 29 April, 2001

Application No. 09/838,137

Docket No.: 10-336US

ON PETITION

This is a decision on the petitions filed herein on:

- 13 June, 2003, under 37 C.F.R. §1.137(a)¹ to revive the above-identified application as abandoned due to unavoidable delay, and in light of the allegations also considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181;² and

¹ A Petition filed under the provisions of 37 C.F.R. §1.137(a) must be accompanied by:

(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application for patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

(2) the petition fee required by 37 C.F.R. §1.17(l);

(3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the reply due date until the filing of a grantable petition pursuant to the is paragraph was unavoidable; and

(4) Any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c).

An application is "unavoidably" abandoned only where Petitioner (or Petitioner's counsel) takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, the response is not timely received in the Office. That is, in the context of ordinary human affairs the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

² The regulations at 37 C.F.R. §1.181 provide, in pertinent part:
§1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. * * *

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

© When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that

- 25 June, 2003, under 37 C.F.R. §1.137(b)³ to revive the above-identified application as having been abandoned due to unintentional delay.⁴

For the reasons set forth below, the petition:

- considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181 is **GRANTED**;
- under 37 C.F.R. §1.137(a) to revive the application alleging unavoidable delay is **DISMISSED** and no fee is charged; and
- under 37 C.F.R. §1.137(b) is **DISMISSED** and no fee is charged.

BACKGROUND

A review of the record reveals:

- it appeared that Petitioner failed to respond timely and properly to the non-final Office action mailed on 8 July, 2002, with reply due (absent extension of time) on or before 8 October, 2002;

there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. * * *

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. * * * (Emphasis supplied.)

³ Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 C.F.R. §1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

⁴ On initial review of the file, it appeared that a petition under 37 C.F.R. §1.181 or §1.137(a) might not prevail, and it was suggested to Counsel that he might find it necessary to file a petition under 37 C.F.R. §1.137(b). In fact he did so. However, upon review of the details of the matter, the relief originally sought was supportable without a petition under 37 C.F.R. §1.137(b).

- the instant application was deemed abandoned at midnight 8 October, 2002;
- Notice of Abandonment was mailed on 7 May, 2003, after the instant petition was filed;
- Petitioner filed via FAX on 7 April, 2003, a letter, which was considered in the Technology Center as a request to withdraw the holding of abandonment, and the request was dismissed on 29 April, 2003;
- Petitioner filed the instant petition (with fee authorization, however, no fee was charged) under 37 C.F.R. §1.137(a) on 13 June, 2003, but he re-advanced his contentions that:
 - he did not receive the Office action of 8 July, 2002;
 - the reason he did not receive the Office action was that it was mailed to his old address;
 - he Noticed the Office of his change of address as related to and associated with Customer Number 24,949 on two occasions--the later of which was a FAX submission (with a confirmation activity report) on 14 March, 2002, wherein he set forth the current mailing address of 3000 Merivale Road, Ottawa, Ontario K2G 6N7 CANADA; and
 - the Customer Number 24,949 was associated with the instant application from the day of its filing by virtue of its placement on the application as filed at the time of filing;
- however, notwithstanding the Notice, on 8 July, 2002, the Office mailed the Office action to 1187 Bank St./Ste. 201, Ottawa, ON K1S 3X7 CANADA;
- with the instant petition under 37 C.F.R. §1.137(a) Petitioner also filed a reply to the 8 July, 2002, Office action;
- Petitioner filed the petition under 37 C.F.R. §1.137(b) on 25 June, 2003, and made therein the statement of unintentional delay.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the

satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).⁵

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.⁶

Delays in responding properly raise the question whether delays are unavoidable.⁷ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁸

And the Petitioner must be diligent in attending to the matter.⁹ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.¹⁰))

⁵ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁶ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁷ See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁸ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁹ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

¹⁰ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Allegations as to the Request to Withdraw
the Holding of Abandonment and
the Petition Alleging Unavoidable Delay

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.¹¹

A delay is not "unavoidable" when an applicant simply fails to file properly and timely the required reply and so permits the maximum extendable statutory period for reply to expire.¹²

In determining if a delay was unavoidable, decisions on reviving abandoned applications have adopted the standard of the reasonably prudent person acting in their most important business matters.¹³ In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."¹⁴

The record reflects that:

- contrary to the holding in the decision of 29 April, 2003, the Customer Number 24,949 indeed was associated by Petitioner with the instant file since the time of filing; and
- Petitioner Noticed the Office on more than one occasion as to changes in address--the latest of which was on 14 March, 2002--to be associated with Customer Number 24,949.

Petitioner has made a satisfactory showing of:

- Notice to the Office of change of address (which apparently was not entered into the Office data base) to the current address current mailing address of 3000 Merivale Road, Ottawa, Ontario K2G 6N7 CANADA on 14 March, 2002; and
- non-receipt of the non-final Office action of 8 July, 2002, because said paper was directed to the wrong address by the Office.

¹¹ See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

¹² See MPEP 711.03(c)(III)(C)(2).

¹³ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

¹⁴ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

CONCLUSION

Accordingly, the petition:

- as considered under 37 C.F.R. §1.181 hereby is **granted**;
- under 37 C.F.R. §1.137(a) is **dismissed**; and
- under 37 C.F.R. §1.137(b) is **dismissed**.

The instant application file is being forwarded to Technology Center 2800 for further processing.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



John J. Gillon, Jr.
Senior Attorney
Office of Petitions